

### **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed November 21, 2005. Upon entry of the amendments in this response, claims 1 – 133 and 139 – 156 are cancelled, and claims 134 – 138 remain pending. Applicants cancel claims merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

#### **I. Claim of Priority**

Applicants are not addressing the validity of all assertions made in the Office Action regarding the priority of this Application. Therefore, Applicants should be not presumed to agree with any statements made in the Office Action regarding the priority of the Application unless otherwise specifically indicated by Applicants.

#### **II. Objections to the Drawings**

The Office Action indicates that the drawings are objected to as failing to comply with 37 C.F.R. § 1.83(a) because they allegedly do not include every feature of the invention specified in the claims, specifically, claims 134, 141, and 156. In particular, the Office Action states that the drawings fail to illustrate “providing a selectable option to select whether the on-demand presentation is to be provided with or without promotional advertising.” In response, Applicants submit that step 213 in FIG. 5 references the display of a title purchase option screen, which in one described example includes the selectable option at issue. Accordingly, Applicants submit that the present application satisfies the requirements of 37 C.F.R. § 1.83(a) since one of reasonable skill in the art would easily understand the claimed invention based upon the illustrations.

**III. Rejections Under 35 U.S.C. § 112**

The Office Action indicates that claims 134-156 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Since claims 139 – 156 have been cancelled, the rejection of those claims is now moot. Regarding claims 134 – 138, the Office Action indicates with respect to claim 134 that the present specification discloses that providing promotional material during playback is functionally separate and distinct from providing promotional advertising when playback is paused for an extended period of time. Applicants have amended claims 134 – 138 to remove the cited limitation, thereby overcoming the rejection under 35 U.S.C. § 112, first paragraph.

**IV. Claim Objection**

The Office Action objected to claim 151 under 37 C.F.R. § 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants submit that through the foregoing amendments, claim 151 has been cancelled, rendering this claim objection moot.

**V. Rejections Under 35 U.S.C. § 103(a)**

The Office Action indicates that claims 134, 136-144, 150, 153, 154, and 156 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 6,628,302 (“*White*”) in view of U.S. Patent Number 5,532,735 (“*Blahut*”). The Office Action further indicates that claim 135 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *White* in view of the “*Movie Trailer Trash*” article. Other claim rejections regarding cancelled claims are considered moot.

In order for a claim to be properly rejected under 35 U.S.C. § 103, the teachings of the cited art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Further, “[t]he PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching

in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

Applicants respectfully traverse these rejections for at least the reason that *White* in view of *Blahut* fails to disclose, teach, or suggest all of the elements of claims 134, 136-144, 150, 153, 154, and 156. More specifically, claim 134, as amended through the foregoing amendments, recites (emphasis added):

134. A television set-top terminal (“STT”) coupled to a server via a bi-directional communication network, said STT comprising:
- memory having at least one program code stored therein;
  - at least one processor that is programmed by the program code to enable the STT to:
    - receive via tuner in the STT media guide data
      - corresponding to a media guide for on-demand rentable video presentations;
    - provide a media guide presentation to a user via a television signal, the media guide presentation comprising at least a portion of the media guide data
      - corresponding to a plurality of on-demand rentable video presentations;
    - responsive to presentation specific rent flags received from the server, enable a plurality of user-selectable rental options*** specific to each one of the plurality of on-demand rentable video presentations in the media guide presentation;
    - configure a first rental option in the plurality of user-selectable rental options to provide a ***user-selectable option to view a user-selected on-***

*demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation* of the user-selected on-demand rentable video presentation;  
configure a second rental option in the plurality of user-selectable rental options to provide a *user-selectable option to view a user-selected on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately prior to presentation* of the user-selected on-demand rentable video presentation;  
receive a first user input corresponding to a selection of one of the plurality of on-demand rentable video presentations in the media guide presentation;  
provide the first rental option and the second rental option to the user responsive to the first user input;  
receive a second user input responsive to providing the first rental option and the second rental option;  
provide the one of the plurality of rentable video presentations to the user without presentation promotional advertising during the presentation and without preceding movie trailers responsive to the second user input corresponding to the selection of the first rental option and the second rental option;  
and  
suspend the provision of the rentable video presentation and provide the user with suspension promotional advertising responsive to third user input, *wherein the suspension promotional advertising provided during suspension of the presentation is*

*configured by the server and is independent of the particular presentation and independent of the first rental option and the second rental option.*

Applicants submit that the cited references do not disclose or render obvious at least the elements emphasized above. Namely, the cited references do not show or render obvious an STT programmed to, based on *presentation specific rent flags received from the server, enable a plurality of user-selectable rental option*, including a *user-selectable option to view a user-selected on-demand rentable video presentation without presentation promotional advertising that is otherwise shown during presentation* and a *user-selectable option to view a user-selected on-demand rentable video presentation without preceding movie trailers that are otherwise shown immediately prior to presentation*, and further *wherein suspension promotional advertising provided during suspension of the presentation is configured by the server and is independent of the particular presentation and independent of the first rental option and the second rental option.*

Even if the *Movie Trailer Trash* article refers to movie trailers in movie theaters, the article does not disclose providing movie trailers preceding on demand rentals, much less the claimed limitation of providing a user-selectable option to view a presentation without the movie trailer, and it would be illogical to suggest the notion of allowing individual viewers in movie theaters to control whether movie trailers are shown since other viewers are often in the audience. Applicants further contend that it would not be obvious to provide an STT that enables a user, based on presentation specific rent flags, to **prevent** presentation advertising and preceding trailers **while also independently providing suspension advertising**. Applicants submit that, outside the present application, motivation to combine these **otherwise seemingly contradictory** claimed elements simply does not exist.

In addition, dependent claims 135 – 138 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 134. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

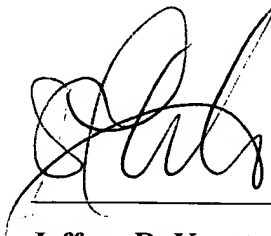
Also, the Office Action states that it is known and desirable to “provid[ing] a user option to select whether the on-demand presentation is presented with promotional advertising” such that the user is operable to adjust billing based upon the level of advertising desired. In addition, the Office Action states that, “the existence of promotions or “movie trailers” is notoriously well-known in the art. Also, the Office Action states that, it is known in the art to distribute video over a “second communication channel” using QAM and to further distribute TCP/IP data via a “first communication channel” using QPSK modulation. The Office Action also states that it is known and advantageous to provide “updated portions of promotional advertising corresponding to a merchandise advertisement tailored for the user of the STT.” Applicants respectfully submit that all of these statements need proof. Thus, to the degree that Applicants would otherwise be considered to admit that any of these statements are so well-known that proof would not be required, Applicants traverse such findings for the reason that they are too detailed and were presented in the context of claimed combinations that are too complex to be considered well-known.

### **CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Further, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known because of the complexity of the claimed limitations.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. Kuester', is written over a horizontal line.

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